IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

NO. 781

PITTSBURGH-ERIE SAW CORPORATION, Petitioner

v.

SOUTHERN SAW SERVICE, INC., Respondent

REPLY BRIEF FOR PETITIONER ON PETITION FOR WRIT OF CERTIORARI

AS TO RESPONDENT'S "STATEMENT OF THE CASE" (R. Br. 2-4*)

Respondent states (R. Br. 3):

"The evidence does not support petitioner's statement that the machine was built solely as a model and that respondent's only reason for building the same was to show it to Petitioner (Petition pp. 8-9)".

Respondent is in error. Petitioner's statement at pages 8-9 of the petition to which respondent refers is founded squarely upon the District Court's Finding of Fact No.

* References to Respondent's "BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI" are by "R. Br." followed by the page number. References to the Petition for Certiorari are by "P." followed by the page number. References to the Appendix to the Petition for Certiorari are by the page numbers thereof, as A-1, A-2, etc.

13 (A-5, 6) to which reference is respectfully made. Such holding was accepted by the Court of Appeals and formed the basis for the Court of Appeals' consideration of the issue of intervening rights (A-16). Respondent seems to be suggesting that this Court should look back of the concurrent findings of fact of the District Court and the Court of Appeals and find the facts for itself. This court will not do so "in the absence of a very obvious and exceptional showing of error" (*Graver Mfg. Co. v. Linde Co.*, 336 U. S. 271, 275, and cases cited) which does not exist here.

Respondent states (R. Br. 4) that the Chief Judge of the Court of Appeals and the District Judge ruled in favor of plaintiff "for entirely different reasons" and "from all that appears in the Record, the District Judge might well agree with the majority opinion of the Court of Appeals on the point at issue here". Again respondent is in error. The reason for the ruling of the District Judge is contained in his Conclusion of Law No. 9 (A-10) to which reference is respectfully made. The reason for the ruling of the Chief Judge of the Court of Appeals is clearly set forth in the last four lines of his dissenting opinion (A-28) and is based on precisely the same reasoning as the District Court's ruling.

Respondent (R. Br. 4) takes issue with petitioner's statement that respondent materially altered the accused machine in 1953, yet quotes the District Court's finding that prior to 1953 the "machine lacked elements necessary for commercial operation" (A-6). No argument is required to support the conclusion that if prior to 1953 the machine lacked elements necessary for commercial operation and it was thereafter placed in con-

dition to be operated commercially and was so operated, as respondent admits (R. Br. 3), the machine must have been materially altered. Respondent is playing on words. The point involved is that the machine *was altered* and that if respondent has intervening rights such rights under the statute can apply only to the machine *in its condition prior to being altered,* no matter what adjective be used to modify "altered".

The footnote to the opinion of the Court of Appeals (A-19) to which respondent alludes (R. Br. 4) relates to an entirely different matter, to wit, whether the modification of the machine was so great as to "warrant a finding that the machine was 'made or purchased' after the reissue". Since the machine existed prior to the reissue, albeit in a different form, it is clear that the Court of Appeals was eminently correct in holding that it was not "made or purchased" after the reissue; but that holding is not a holding affecting in any way the fact found by the District Court (A-6) and admitted by respondent (R. Br. 4) that the machine was changed in 1953 sufficiently to convert it from a non-commercial machine or "model" (A-5) into a commercial machine.

A Question of Public Importance is Involved

AS TO RESPONDENT'S CONTENTION THAT "NO QUESTION OF PUBLIC IMPORTANCE IS INVOLVED" (R. Br. 4-6)

Respondent's argument (R. Br. 4-6) inadvertently emphasizes the great public importance of the issue of this case. Respondent states (R. Br. 5):

> "It is apparent therefore that this case deals with a segment of mechanical engineering of little or no public importance. As stated above, the only point is whether or not respondent may continue to use one such machine which cost Thirteen Hundred Sixty-Four ($1364.00) Dollars".

That is the narrow question between the parties but it is *not* the legal question with which the public is concerned. That question and the future effect in the event that the decision below stands are set forth at pages 16 and 17 of the Petition, to which we respectfully refer.

Respondent further states (R. Br. 6):

> "In an effort to find an issue of public importance, petitioner now argues that respondent's rights should be granted only at the discretion of the Court. This argument flies in the teeth of the statute and is clearly without merit".

That satement is *ipse dixit;* respondent does not enlarge upon it or demonstrate its truth. Actually the contrary is the truth. Petitioner's argument (P. 15) is that the statute before the Court must be construed as a whole; Chief Judge Hutcheson held (A-28):

> ". . . the statute, in line with decisional law under Section 64 of the earlier statute remits the matter to the discretion of the court".

A Question of Public Importance is Involved

Use of *discretion* by the court versus *"absolute right"* (A-19)—that is the question involved in this case. The District Judge and the Chief Judge of the Court of Appeals held that intervening rights should be barred to respondent because they have the obligation to use discretion to determine whether under the facts of the case there ought to be intervening rights and they have found that there ought not to be. The two junior judges of the Court of Appeals held (A-19) that "Section 252 gives appellant an *absolute right** to *continue using* it *without regard to the extent of its use prior to reissue*", giving no effect to the last sentence of the section (P. 5).

The Annual Indices of Patents published by the United States Patent Office show that each week an average of three to four reissue patents are granted. Patents which are reissued are virtually always important patents and are frequently destined for litigation. Respondent tries to make it appear that the intervening rights statute is not likely to be involved in many cases, but there is no reason to suppose that there will be less controversy with respect to intervening rights under the new law than under the old, especially in view of the provision for the exercise of discretion by the court which is embodied in the new statutory law. Under the old law there are a large number of intervening rights decisions. A few of them are cited at pages 18 and 19 of the Petition. It can be anticipated that new Section 252 will be invoked frequently and regularly, and *the purpose of the statute will be defeated* if intervening rights are granted to anyone who does no more than build a *model* machine to use as *trading material*

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* Emphasis in quotations ours throughout this brief.

in an effort to obtain a license under the patent with the *affirmative intention* of *not* using the model machine and who makes no commercial use thereof and who *does not assume a posture adverse to the patent.* That is undoubtedly one of the situations intended to be covered by the last sentence of Section 252 (P. 5).

In *Sacher et al. v. United States,* 343 U.S. 1, this Court granted certiorari for the purpose of "clarifying the permissible practice" under an act (18 U.S.C. 401) providing for use of discretion by the court. We submit that in the present case certiorari should be granted to insure that henceforth the courts will not, as the majority of the Court of Appeals did in the present case, refuse to give effect to the last sentence of Section 252 providing for the use of discretion by the court.

Respondent further contends (R. Br. 6) that

> ". . . the claim that the old law still applies, by the mere passage of time, becomes unimportant".

Determination in the present case that the old law applies is of paramount importance because the majority of the Court of Appeals has undertaken to apply the new law where it is not applicable and further has *misapplied or misconstrued* it. The public policy reason for a determination that the old law applies is not for a construction of the old law (it has been amply construed—P. 18-19) but to *rectify the erroneous construction of the new law.* Since the old law is applicable the new law is not, and its erroneous construction by the majority of the Court of Appeals should be nullified.

AS TO RESPONDENT'S CONTENTION THAT "UNDER THE NEW LAW RESPONDENT IS ENTITLED TO AN INTERVENING RIGHT" (R. Br. 6-9)

Respondent's whole argument on this point (R. Br. 6-9) fails to give effect to the all-important last sentence of Section 252 (A-5). At page 7 of its brief respondent quotes only the first sentence of the second paragraph of Section 252, omitting the provision for use of discretion by the Court. Respondent's argument based on the House of Representatives Report and the Federico Commentary (R. Br. 7-9) fails to properly interpret those documents. The word "made" in the statute, which word respondent emphasizes, is used to refer to something which *is being used or sold,* for even in the first sentence of paragraph 2 of Section 252 which respondent quotes at page 7 of its brief the right which is granted is "to *continue* the use of . . . the specific thing so made" (P. 5, R. Br. 7). If the thing "made" is only a model which is not used, obviously one cannot *continue* to use it. Neither the House of Representatives Report nor the Federico Commentary contemplates the conclusion reached by respondent—that the statute gives a right to *continue* use when *there is no use to be continued.*

AS TO "THE EXTENT OF RESPONDENT'S INTERVENING RIGHT" (R. Br. 9-10)

This portion of respondent's brief is answered above at pages 2 and 3. Respondent continues to play on words and contend that its machine was not materially altered in 1953. We have demonstrated above that it *was* materially altered in 1953.

It is significant that respondent does not traverse the legal basis for petitioner's contention that if respondent has an intervening right that right can apply only to the machine as it existed prior to 1953. Respondent's argument is tantamount to an admission of the correctness of petitioner's legal position as to the extent of respondent's intervening right.

AS TO RESPONDENT'S CONTENTION THAT "NEW SECTION 252 APPLIES" (R. Br. 10-12)

The glaring fallacy in this section of respondent's brief is the statement at page 10, after quoting Section 4 (a) of the Act of July 19, 1952, that

> "Nothing is otherwise provided about intervening rights".

In that statement respondent is wrong. There is a clear provision about intervening rights in Section 5 (P. 5), to wit,

> "Any rights or liabilities now existing under such [repealed] sections or parts thereof shall not be affected by this repeal".

Old title 35, Section 64, was one of the repealed sections (P. 5) Therefore the effect of Section 5 is to preserve

petitioner's right to the grant of a reissue patent in accordance with old Section 64, that is, free from the restriction of new Section 252 that the patent is subject to intervening rights by one who made the patented thing prior to the reissue but did not infringe any claim carried over from the original patent into the reissue patent.

None of the cases cited by respondent is applicable to the facts of the present case. Respondent's primary authority, *Hazeltine Research v. Avco Mfg. Corp.*, 227 F. 2d 137, did not involve Section 252 or any question of intervening rights. In none of the cited cases was there involved the taking away by application of the new law of a right existing under the old law as there is here.

It is submitted that the old law clearly applies in this case.

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No. 876

SOUTHERN SAW SERVICE, INC., *Petitioner*

v.

PITTSBURGH-ERIE SAW CORPORATION, *Respondent*

CONDITIONAL CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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No.

SOUTHERN SAW SERVICE, INC., *Petitioner*

v.

PITTSBURGH-ERIE SAW CORPORATION, *Respondent*

CONDITIONAL CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Cross-Petitioner, Southern Saw Service, Inc., originally defendant and appellant in the courts below, prays conditionally that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered November 27, 1956; rehearing denied January 3, 1957.

As respondent in Case No. 781 in this Court, cross-petitioner has filed its response and brief urging the denial of the application for the writ of certiorari. It believes that such writ should be denied. However, if the Court sees fit to grant said application, then cross-petitioner believes that this Court should take

the whole case and reverse the decision of the Court of Appeals on questions decided adversely to cross-petitioner.

OPINIONS BELOW

The opinion of the United States District Court for the Northern District of Georgia (R. 460, A-1)[1] is reported at 136 F. Supp. 96, 107 USPQ 203. The final judgment of the District Court (R. 473, A-12) was entered August 24, 1956.

The opinion of the Court of Appeals (A-13) is reported at 239 F. 2nd 239, 111 USPQ 362.

JURISDICTION

The judgment of the Court of Appeals sought to be reviewed (A-29) was dated and entered November 27, 1956. A petition for rehearing was denied without opinion January 3, 1957 (A-29).

This Court has jurisdiction under 28 U. S. Code 1254(1) and 2101 (c).

This Cross-Petition is presented conditionally, as filed and granted in *McComb* v. *Farmers Reservoir and Irrigation Co.*, 335 U.S. 809, 337 U.S. 755. Rule 21(5).

QUESTIONS PRESENTED

1. Is a reissue patent, granted after cancellation of broad and narrow claims of the original patent, following rejection upon prior art during reissue prose-

[1] As in Petition No. 781, upon which this is conditional, reference to the printed record in the court below are by "R." followed by the page number; and references to the Appendix to the said Petition are by the page numbers thereof, as A-1, A-2, etc. invoking Rule 21(5).

cution, infringed by a machine or a method which did not infringe the original patent claims?

2. Are allegedly broadened claims valid, in a reissue patent describing a single embodiment of apparatus and method, when narrow claims of the original patent were rejected upon prior art and cancelled?

3. Are allegedly broadened claims of a reissue patent, framed with knowledge of competing structures known to exist prior to the reissue application, valid?

4. Must a reissue patent claim, claiming a combination of old elements, set out an unexpected and non-obvious result?

STATUTES INVOLVED

The new Patent Act, 35 U.S. Code, became effective January 1, 1953, and includes the following sections:

"103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

"251. Reissue of defective patents

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a de-

fective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent, and in accordance with a new and amended specification, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

"The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

"The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent (R.S. 4916; 35 U.S.C., 1946 Ed. 64)."

STATEMENT OF THE CASE

On March 9, 1954, cross-respondent sued cross-petitioner for infringement of United States reissue patent No. 23,231, granted May 16, 1950 (R. 12, 483). Cross-petitioner admitted making the accused endless band saw blade wrapping machine in July, 1948, and operating it, prior to the grant of the reissue patent in suit, and contended that the machine does not infringe the reissue patent (R. 16, 20, 25) and also pleaded invalidity (R. 20-23) and intervening rights

(R. 19). Both courts below held all of the claims in suit, being claims 20, 23, 24 and 25, valid and infringed (A-9, 10, 21, 25).

The basis of the federal jurisdiction in the District Court was 28 U.S. Code, Sections 1338 (a) and 1400 (b). (R. 13).

The principal Petition No. 781 involves only the issue relating to intervening rights.

This conditional cross-petition seeks review of the court holdings of infringement and validity of the reissue patent in suit.

The issues involved in this cross-petition are issues of law, based upon the record. No issue of fact is here urged.

The original Wilson and Wilson patent 2458971 was granted January 11, 1949, on an application filed February 27, 1946. Application for reissue was filed November 29, 1949, and the reissue patent in suit, No. 23,231, was granted May 16, 1950. (R. 488).

The original patent had 19 claims (R. 490-491). During the reissue prosecution, prior art was cited (R. 492) and original patent claims 2-10, 13-16, 18 and 19 were cancelled. Original patent claims 11 and 12 were rewritten as reissue claims 21 and 22, and are not charged with infringement in this suit. Original patent claim 1 was amended, as shown by italics and bracketed deletions (R. 490), charge of infringement thereof was withdrawn at trial. Only original patent claim 17 (R. 491) was unchanged; and has not been charged as infringed. After reissue prosecution, the reissue was granted with amended claim 1, original claim 17, rewritten claims 21 and 22, and claims 20, 23,

24, and 25 which are new in the reissue and were not in the original patent. These facts appear upon the face of the printed reissue patent.

Copies of the patents of the prior art, cited in the prosecution of the reissue patent application, appear at R. 501-572.

About one month after filing the application for reissue, on or about December 16, 1949, the patentee and cross-respondent brought suit against one Valiquet, in the Eastern Division for the Northern District of Illinois, alleging infringement of the original patent (R. 33, 43: Interrogatory 73 and Ans.). This suit was supplemented when the reissue was granted (R. 34, 43: Intg. 79 and Ans.). The suit was settled by agreement of parties (R. 34, 43: Intg. 80 and Ans.) on August 9, 1950, and on the same date said Valiquet assigned (R. 45-47) a pending patent application to cross-respondent, which later became the Valiquet patent 2624166 (bound at R. 602-607). A consent Judgment as entered (R. 44-45) on August 10, 1950.

ARGUMENT

This conditional petition is presented for the reason that if this Court grants the principal Petition N. 781, for adjudication of questions of applicability and interpretation of the new Patent Law as to intervening rights under reissue patents, then rights of the public, including the cross-petitioner, under the same law should also be adjudicated as to scope and validity of reissue patents.

There is the same public interest in determination of the intent and effect of the new statute as to the present status of scope and validity of reissue patents,

as in the present status of intervening rights under reissued patents. Indeed, the reissue patent in suit has already been used in suit against another competitor, with procurement of a consent decree and the competitor's assignment to cross-respondent of a pending patent application.

REASONS WHY THE WRIT SHOULD BE GRANTED ON THIS CONDITIONAL CROSS-PETITION

The writ of certiorari prayed for conditionally should be granted with Petition No. 781, if the latter be granted, for the following reasons:

1. The Court of Appeals has decided a federal question, and interpreted the new Patent Act, particularly as to the sections thereof relating to reissue patents, in a way in conflict with applicable decisions of this Court.

2. The Court of Appeals has decided a federal question, to wit: the validity and infringement in law of reissue patents, in a way in conflict with applicable decisions of this Court.

3. The Court of Appeals has decided a federal question, to wit: intervening rights under a reissue patent, on the basis of the new law; and if this Court grants certiorari and then holds that the old law applies in this cause, then the validity and scope should also be determined under the old law and in line with prior decisions of this Court.

VALIDITY AND SCOPE OF REISSUE CLAIMS

The Court of Appeals failed to take into consideration the acknowledgement of prior art made by the patentee, cross-respondent herein, by cancellation of original patent claims after rejection during the re-

issue prosecution, as so-called file wrapper estoppels. This Court, in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 218, said:

> "Where the patentee in the course of his application in the Patent Office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived or restored to the patent by reading it by construction into the claims which are allowed * * *"

It is contended that this doctrine applies to allegedly broadened reissue claims, and that their construction and scope should be determined in the light of original patent claims surrendered by cancellation during reissue prosecution; and that the effect of the doctrine is that broadened reissue claims are either strictly limited in scope to the apparatus and method described in the specification or, alternatively, that the reissue claims are invalid as being addressed to a different invention than that covered by the original patent claims.

The Court of Appeals failed to take into consideration section 103 of the new Patent Act, which denies patentability to subject matter "obvious at the time the invention was made to a person having ordinary skill in the art", and the admissions of the patentee in cancelling claims, thereby conceding that it was obvious to such persons to assemble the teachings of the prior art in the ways and fashions set out in the allegedly narrow claims of the original patent.

The Court of Appeals held (A-23) that the patent in suit calls for a combination of old elements, and

then failed to take into consideration the decisions holding that a combination of old elements even though it produces a new and useful result, is unpatentable unless the result is non-obvious, surprising or unexpected: and the decision, unless it is reversed, will have an effect not only contrary to the intent of Congress, but will support as validly patentable various assemblies of old elements or steps in combinations having only trivial and titular novelty over the prior art.

This Court has held that courts should scrutinize patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements: *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152. Here, the similarity of result is in the wrapped article, which is not patented; and the decision, if not reversed, will have the effect of supporting the validity and scope of patents upon apparatus or methods so broadly as to preclude the public from producing the unpatented article by other means or methods.

The Court of Appeals (A-24) reversed the trial Court as to the "pioneer" status of the patent in suit, but held that the invention was of such novelty and importance as to mark a distinct step in the progress of the art, without finding or holding that the step was non-obvious, surprising or unexpected; and further erred in holding that the patentee was entitled to liberal, and not limited or narrow treatment and construction as to the range of equivalents (A-25). This decision of the Court of Appeals, unless it is reversed, will have the effect of supporting as valid and infringed, claims of a reissue patent which are broader than original patent claims cancelled after

rejection upon prior art during the reissue prosecution, and of bringing apparatus and methods not taught by the patent description and derived from the prior art under the reissue claims.

The Court of Appeals failed to take into consideration, in its decision as to reissue claims 20 (A-19, to A-22; quote A-20) that this apparatus claim contains no structural element for supporting the band which is to be wrapped, and therein differs from all apparatus claims of the original patent, in that the latter set out a table as a supporting element. Therein Claim 20 is addressed to new matter and to a different invention, as this Court held in *United States Industrial Chemicals, Inc.* v. *Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (where the original patent description and claims stated the inclusion of water in a process), stating:

> "This court has uniformly held that the omission from a reissue patent of one of the steps or elements prescribed in the original, thus broadening the claims to cover a *new and different combination,* renders the reissue void, even though the result attained is the same as that brought about by following the process claimed in the original patent."
>
> "In Gill v. Wells, 22 Wall. 1, the original patent disclosed and claimed a machine for making hat bodies. One of the elements of the machine was a tunnel through which a current of air was to be passed. The specifications did not indicate that this part could be omitted. The reissue for a machine without any tunnel, was held invalid."
>
> (Emphasis supplied).

The Court of Appeals failed to take into consideration the fact that the patentee, during the reissue prosecution, knew of and was in fact suing as infringement a machine operated by one Valiquet, a competitor: and to consider decisions of this Court that reissue claims molded and formed with knowledge of devices made by others, for the purpose of a broadened reissue, are invalid. This Court has not ruled on this, at a time after the new Patent Act became effective; and the issue of validity and scope of claims so framed becomes dominant and of public interest if this Court grants Petition No. 781.

This Court, in *Eby* v. *King,* 158 U.S. 366, has held that it is not competent for a patentee to abandon, in toto, claims of the original patent which are void because of anticipation, and reconstruct his patent upon a different theory, to hold as infringers other manufacturers who had entered the field.

This doctrine of invalidity of reissue claims which are based upon abandonment of a part forming an element of the original patent claims also appears in *McMurray* v. *Mallory,* 111 U.S. 97, and *Dunham* v. *Dennison,* 154 U.S. 103.

SURVIVAL AND APPLICABILITY OF PARTS OF THE OLD LAW

In the principal Petition No. 781, petitioner has contended that the old law applies to this cause, and that the transition clauses of the new law provide this.

The Court of Appeals held that the new law applies, and not the old law.

This conditional cross-petition is presented, for the reason that if the principal Petition is granted, and

this Court reverse this decision of the Court of Appeals, then the validity and scope of the reissue patent also should be determined under the old law.

The Congressional proceedings, and commentaries, state that some parts of the new law are repetitions of the old, that other parts set down or codify court practice under the old law, while yet others are entirely new. It is herein contended that a patent reissued under the old law cannot have greater validity or scope under the new statute, or by survival under the transition clauses thereof, than it had under the old law and decisions thereon, and that public rights under the old laws, as to validity and scope of reissue claims, are preserved under the new law. If this Court grants the principal Petition No. 781, and holds that intervening rights under reissue patents, in causes such as the present one, are to be determined under the old law, then the status of public rights and under the old law, as to validity and scope of such reissue patents, and the preservation thereof under the new law, should be reviewed and determined.

CONCLUSION

Cross-petitioner prays that this petition for a writ of certiorari be granted, conditioned upon the grant of writ of certiorari upon Petition No. 781.

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